

## REMARKS

Claims 1-19 stand rejected. Claims 20-22 are being added herein. Therefore, claims 1-22 will be pending following entry of this amendment.

### Rejection Under 35 U.S.C. §103

Claims 1-19 were rejected as being unpatentable under 35 U.S.C. §103 over Gagen. The rejection identified passage 82 in the reference as corresponding to the claimed passageway that the pending claims state provides a fluid path between the first and second chambers. However, the Office Action then admits that the Gagen passage 82 extends between what correspond to its second and third chambers.

The rejection then makes the unsupported conclusory statement that:

“It would have been obvious to one of ordinary skill in the art at the time that the invention was made to connect the passageway between the first and second chamber in the device of Gagen in order to ensure that there is always a positive pressure in the second chamber.”

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art, *Uniroyal Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988); *Ashland Oil Inc. v. Delta Resins & Refractories Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985); *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). It should be

recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification, *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

The Office Action has failed to demonstrate:

1. Why it is desirable to ensure that there is always a positive pressure in the second chamber; and
2. How the prior art leads a skilled artisan to provide such positive pressure by connecting the Gagen passageway 82 between the first and second chambers.

First of all it is not desirable always have a positive pressure in the second chamber. When the first poppet 70 is to move from open state to a closed state (from right to left in Gagen Fig. 2), present application (§ [0024]) indicates that a negative pressure in the second chamber 84 would desirably dampen the closing motion of the first poppet 70 in the present application describes the desirability of dampening that closing action, which dampening is the essence of the present invention.

Secondly nothing in the Gagen patent would have led one of ordinary skill in the art to alter the passage 82, much less to do so by connecting it to the first chamber 68 instead of the third chamber 66. With the reference teaching away from the present invention, the rejection has a very high burden of proving why the proposed alteration is obvious.

In addition, claim 1 states that the passageway has a dampening orifice. No where in the Gagen patent is such an orifice mentioned nor is the concept of the passage 82 dampening the valve action mentioned. Conventional practice is to provide a passage like 82 in Gagen that is sufficiently large to allow flow into and out of the chamber 84 that does not restrict motion of the plunger 76, i.e. the opposite of the present invention. Therefore, in the absence of a suggestion about dampening or the passage 83 restricting flow, the presently claims hydraulic valve are not obvious to a skilled artisan.

Dependent claim 3, 9-12, and 16 further describe this dampening action.

Therefore, the rejection has failed to meet that burden and has not established a case of *prima facie* obviousness under 35 U.S.C. §103.

### **New Claims**

New claims 20, 21 and 22 depend respectively from independent claims 1, 9 and 17 and specify that the first poppet is separate from and able to slide within the main bore independently of the second poppet. As shown in Figure 1 and described in paragraph [0014] of the present application, the two poppets 38 and 58 merely abut each other in aperture 54. That is not true of the assembly in the Gagen patent in which the alleged second poppet is screwed into the first poppet, so that both pieces move in unison at all times


Therefore, the subject matter of the newly added claims is patentably distinct from the cited art.

## Conclusion

In view of these distinctions between the subject matter of the present claims and teachings of the cited patents, reconsideration and allowance of the present application are requested.

Respectfully submitted,  
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